

Attorney Docket No. SteffanE_P_1_03
Amendment dated December 9, 2004

Application No. 10/614,304
Reply to Office action of September 09, 2004

REMARKS/ARGUMENTS

In the Specification, the Abstract has been amended according to Examiner's objection of the use of the term "means" in the abstract. The term "members" now replaces "means".

Claims 1, 6, and 15 are currently amended (*i.e.*, appropriately corrected) to comply with Examiner's objections regarding formalities.

In view of the above amendments and the following remarks, reconsideration of the outstanding Office Action is respectfully requested.

1. The alternative rejection of currently amended (*i.e.*, corrected per Examiner's objection) Claim 1 under 35 USC § 102(b) as being anticipated by Jamieson *et al.* (U.S. Patent No. 2,647,762) is respectfully traversed.

According to MPEP 706.02(b) a rejection based on 35 U.S.C. 102(b) can be overcome by persuasively arguing that the claims are patentably distinguishable from the prior art. Therefore, as all the elements of the claim in question are not present in Jamieson *et al.* patent, the claim in question is not anticipated by Jamieson *et al.*, and is, thus, patentably distinguishable from the art disclosed by Jamieson *et al.*

With respect to currently amended Claim 1, Claim 1 encompasses a:

"A foldable golf-bag transporting hand-cart/golf-bag assembly, comprising:

- a) a golf-bag;
- b) a foldable golf cart, and

c) mounting means for securely, reversibly mounting said golf-bag on said golf cart, where said mounting means provides provide for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members."

To reiterate: Applicant's claims a hand-cart/golf-bag assembly mounting means that provides for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members.

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As understood by Applicant, Jamieson *et al.* does not teach a golf bag carrier that maintains the golf club bag in a stable vertical position while at rest, for example while a golfer is golfing. It appears to Applicant that Jamieson *et al.* disclose a folding golf bag carrier that, while at rest and supporting a golf bag, maintains the bag at an inclined position. In fact, Figure 2 shows a golf bag supported by the folding golf bag carrier taught by Jamieson *et al.* in an at rest position. "The bottom of the frame member 10 is bent around as shown at 42 to form a portion which may rest on the ground when the device is in use to hold it in an upright position while the player is engaged in his game and leaves the device standing nearby." Lines 53 – 57. "Upright position" as used by Jamieson *et al.* does not mean a vertically upright position. It means, according to the drawing, that the bag is inclined from vertical about 45 degrees. As was stated in Applicant's application as filed, the bag holders that are known to Applicant all support a golf bag in such an inclined position which can make the retrieval of a desired golf club from the bag difficult as the desired club might be under a number of other golf clubs that are leaning on top of the desired club. This arrangement also can make the bag unstable and apt to fall over onto the ground.

Applicant's invention, as originally claimed, solves this problem, among others, by providing for the cart to hold the bag vertically upright, that is so that the axis of the bag is perpendicular to the ground surface, while the cart is at rest allowing for easy identification and removal of a desired club from the bag, as well as holding the bag in a more stable upright position.

As it is well-settled that a reference cannot anticipate a claim unless that reference teaches and shows each and every recited feature of that claim, and as Jamieson *et al.* do not teach nor show a ". . . hand-cart/golf-bag assembly mounting means that provides for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members . . .", Applicant respectfully declares that independent Claim 1, for the reasons given above, to be patentable over the cited reference.

2. The rejection of Claims 1 -3, 6, 8, and 19 under 35 USC § 102(b) as being anticipated by Nordland (U.S. Patent No. 3,580,533) is respectfully traversed.

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According to MPEP 706.02(b) a rejection based on 35 U.S.C. 102(b) can be overcome by persuasively arguing that the claims are patentably distinguishable from the prior art. Therefore, as all the elements of the claim in question are not present in the teachings of, nor shown by, Nordland, the claims in question are not anticipated by Nordland, therefore are patentably distinguishable from the art disclosed by Nordland, and, thus, Nordland cannot be used as an anticipatory reference.

It is Applicant's understanding that Nordland teaches a golf cart mounting apparatus that requires a removable biasing pin "... with an enlarged head portion 90 . . ." which must be "... inserted into aligned passages 84 and 86 ..." to rigidly maintain the stem 78 of the bag with the frame of the cart (see lines 43 – 46), or conversely, to remove the bag from the cart, the pin must first be removed. This moveable part is small and not being otherwise attached to the apparatus is prone to being misplaced or lost when not in use.

A biasing means is well-known and accepted to be a means used to influence, predispose, or control the movement of a piece of machinery. Nordland's biasing pin controls, as in "maintains" the stem portion of the mounting means of the golf bag in its predetermined position on the mounting means of the cart frame so that the stem, and, thus, the bag, will not move away from and fall off of the cart frame.

Applicant however, teaches and claims, ". . . mounting means for securely, reversibly mounting said golf-bag on said golf cart, where said mounting means provides provide for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members." [emphasis added].

In Paragraph [0034] of the Application as originally filed, Applicant teaches:

"FIG. 2e is an exploded view better illustrate bag-affixed upper mounting assembly member 34 having wedge-shaped coupling protrusion 34a that is complementary to mounting recess 32a of cart-affixed upper mounting assembly member 32. When member 34 is mounted together with member 32 upper mounting assembly 30 is formed (see FIG. 1). The mounting assembly of this embodiment provides for easy and quick mounting of bag to cart resulting in a tight, secure bag-to-cart connection in one simple movement. Instead of threading and tightening mounting straps or having to adjust fittings or biasing means, the bag is lifted only a few inches so that the bag-affixed mounting members are aligned over the cart-

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affixed mounting members and the bag is then dropped into position. To remove the bag from the cart, the golfer need only lift the bag up a few inches and the bag is released. The invention, as taught, provides for a mounting procedure that is much less tedious than the systems presently available. The mounting procedure, of this invention, takes only seconds, as does the dismounting procedure. Once mounted the sliding dovetail connection of this embodiment assures that the bag is securely positioned on the cart until the golfer deliberately dismounts the bag. Another benefit of this mounting assembly is that no tools are required. Additionally, the mounting assembly as taught herein is free from the need for biasing or, otherwise moving parts, thus significantly reducing the possibility of breakage and the need to replace or repair broken or worn parts. It is obvious, therefore, that the invention disclosed herein has responded to the heretofore unmet need in the art for means to quickly, easily, and reversibly secure a golf-bag to a hand-cart [emphasis added].

As it is well-settled that a reference cannot anticipate a claim unless that reference teaches and shows each and every recited feature of that claim, and as Nordland does not teach a ". . . hand-cart/golf-bag assembly mounting means that provides for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members . . ." as is claimed by Applicant, Applicant believes independent Claim 1, for the reasons given above, to be patentable over the cited reference.

Regarding Claim 2, Claim 2, besides depending on Claim 1 and thus being patentable for the reasons just presented, additionally recites:

". . . wherein the reversible mounting of the first and third mounting members onto the second and fourth members, respectively providing for secure, reversible mounting of said golf-bag on said golf cart free from the need to use straps, a biasing mounting member, or moveable mounting parts" [emphasis added].

As Nordland does not teach mounting a golf bag onto a golf cart wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts, Nordland cannot be used to anticipate Claim 2, thus Applicant respectfully submits that Claim 2 is in condition for patenting.

Furthermore, regarding Claim 19, which recites the:

". . . secure, reversible mounting of said golf-bag on said golf cart free from the need to use straps, a biasing mounting member, or moveable mounting parts" [emphasis added],

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Nordland does not teach mounting a golf bag onto a golf cart wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts. Nordland cannot be used to anticipate Claim 19, thus Applicant respectfully submits that Claim 19 is in condition for patenting.

Regarding Claims 3, 6, and 8, which claims all depend indirectly from Claim 1 and directly from Claim 2 and therefore recite all of the limitations of the claims from which they depend, are also patentable, for the reasons given above.

3. The rejection of Claims 4 and 9 under 35 USC § 103(a) as being unpatentable over Nordland (U.S. Patent No. 3,580,533) as applied to Claim 2 above and further in view of Holtz (U.S. Patent No. 4,950,003) is respectfully traversed as Applicant respectfully contends that Examiner, for the reasons given below, has not established a *prima facie* case of obviousness.

MPEP 2143: To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. That is: "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), and moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Analyzing the subject matter "as a whole" as required by *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) Applicant provides for a device wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts. Nordland, as discussed above, does not teach or show wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts, such as Nordland's requiring the use of pin 88.

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Thus, it is shown that Nordland does not teach all of the limitations claimed by the present invention, and as Holtz does not teach a cart for a golf bag or for any similar type of bag, it therefore follows that dependent Claims 4 and 9 are nonobvious under 35 U.S.C. 103. Therefore, it is respectfully submitted that a *prima facie* obviousness of a claimed invention has not been established and that Claims 4 and 9 are, thus, patentable.

4. The rejection of Claim 7 under 35 USC § 103(a) as being unpatentable over Nordland (U.S. Patent No. 3,580,533) as applied to Claim 2 above and further in view of Kao *et al.* (U.S. Patent No. 5,829,585) is respectfully traversed as Applicant respectfully contends that Examiner, for the reasons given below, has not established a *prima facie* case of obviousness.

Nordland, as discussed above, does not provide for a device wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts, such as Nordland's requiring the use of pin 88 to maintain the connection between the bag and the support.

Thus, it is shown that Nordland does not teach all of the limitations claimed by the present invention, and as Kao *et al.* teach a support frame that is rigidly fixed to the golf bag (see Abstract, line 4, and Figure 1 that shows rigidly affixing pin 40, for example) so that a golf bag cannot be reversibly mounted and dismounted to the support frame, as compared to Applicant's device, for which reversible mounting is claimed in Claim 1, "...mounting means for securely, reversibly mounting..."

from which Claim 7 indirectly depends, it is thus shown that neither alone, nor in combination, do Nordland and Kao *et al.* teach all of the limitations of Applicant's Claims 1, 2, and 7, and as, according to MPEP 2143, the prior art reference must teach or suggest all of the claimed limitations it follows that dependent Claim 7 is nonobvious under 35 U.S.C. 103. Therefore, it is respectfully submitted that a *prima facie* obviousness of the claimed invention has not been established and that Claim 7 is, thus, patentable.

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5. The rejection of Claim 10 under 35 USC § 103(a) as being unpatentable over Nordland (U.S. Patent No. 3,580,533) as applied to Claim 3 above and further in view of Kao et al. (U.S. Patent No. 5,829,585) is respectfully traversed as Applicant respectfully contends that Examiner, for the reasons given below, has not established a *prima facie* case of obviousness.

Claim 10 indirectly depends from both Claim 1 and Claim 2 and as it was shown above that neither alone, nor in combination, do Nordland and Kao et al. teach all of the limitations claimed by Applicant in Claim 1 and Claim 2, and as, according to MPEP 2143, the prior art reference must teach or suggest all of the claimed limitations it follows that dependent Claim 10 is nonobvious under 35 U.S.C. 103 and thus, patentable.

6. Examiner has acknowledged that Claims 11 - 18 are directed to allowable subject matter.

7. Examiner has objected to Claims 5 and 20 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully asserts that as argued above Claims 1, 2, and 19 are patentable, thus it follows that Claims 5 and 20, that directly or indirectly depend from Claims 1, 2, and 19 are also in condition for allowance.

8. The prior art made of record and not relied on is as cited and has been considered.

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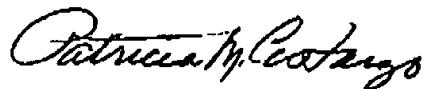
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CONCLUSION

In view of the above amendments (which were limited to corrections made to comply with Examiner's objections) and related arguments, the Applicant believes that the application is now in condition for allowance. Accordingly, favorable reconsideration and early passage to issue of the present Application are most respectfully requested.

Respectfully submitted,



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